



WIP Amatix

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Affymetrix, Inc. (William A. Lyon, et al.))
Application No.: 09/687,932)
Filed: October 13, 2000)
For: METHODS AND COMPOSITIONS FOR)
DETECTING SIGNALS IN BINDING ASSAYS) Art Unit: 1634
Examiner: B. L. Sisson)
Attorney Docket: 04537.017 / 3354)

RESPONSE TO OFFICE ACTION

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Commissioner for Patents
Box RCE
Washington, D.C. 20231

Honorable Commissioner:

Applicants have received an Office action with a mailing date of February 12, 2002 (Paper no. 11). This Office action response is intended to be fully responsive to each of the points made by the Examiner in the Office action.

Amendments

Applicants wish to thank Examiner Sisson for the personal interview that took place on April 10, 2002. It was agreed that the rejection under 35 U.S.C. §112, first paragraph, could be avoided by amending the claims so as to recite methods of signal amplification. Agreement was reached that the case would be refiled as a continuation and the specification would be amended to reflect the current status of cited applications, to provide the generic terminology for products identified by trademarks, and to remove any inconsistencies in the figures. Interview Summary, p. 3.

Applicants have presented clean versions and versions with markings to show changes made in the attached Appendices for Examiner's convenience.

A. In the Claims:

Please cancel claims 1-14 and 19-22, and insert claims 23-31, as shown in Appendix A by a replacement "clean version" of the new claims. The new claims 23-31 contain no new matter.

Applicants have cancelled certain claims and added new claims in a sincere effort to advance prosecution of this application. Applicants reserve the right to pursue the unclaimed subject matter in one or more continuing applications.

B. In the Specification:

Please amend the specification with a replacement substitute specification as shown in Appendix A as a "clean version." A version of the specification with markings to show changes made is included in Appendix B. No new matter is presented in the replacement substitute specification.

C. In the Drawings:

Please amend figures 1-4 with replacement substitute drawings as shown in Appendix A as a "clean version." Figure 5 is included in Appendix A as a "clean version" for Examiner's convenience as no changes were made. A version of figures 1-4 with markings to show changes made is included in Appendix B. No new matter is presented in the replacement drawings.

Remarks

The numbered paragraphs of the Office action are responded to through the corresponding numbered paragraphs below. The applicant has addressed each issue in turn and, for clarity, has provided a heading for each issue.

Claim Rejections – 35 USC §112

1. The Examiner rejected claims 1-14 and 19-22 based on lack of enablement, focusing on the *In re Wands* factors to determine undue experimentation. Paper no. 11, p. 2. Applicants appreciate Examiner's recitation of these factors. Applicants believe it was determined during the in person interview with Examiner, conducted on April 10, 2002, that the rejection under 35 U.S.C. §112 could be avoided by drawing the claims to a method of signal amplification. Interview Summary, p.3. Applicants appreciate Examiner's interview comments. Applicants believe that this reply is fully responsive to this paragraph.

Response to Argument

2-4. Applicants appreciate Examiner's acknowledgement and consideration of Applicants' prior arguments to Paper no. 7. Applicants believe it was determined during the in person interview with Examiner, conducted on April 10, 2002, that the rejection under 35 U.S.C. §112, including undue experimentation, could be avoided by drawing the claims to a method of signal amplification. Interview Summary, p. 3. Applicants appreciate Examiner's interview comments. Applicants believe that this reply is fully responsive to paragraphs 2 through 4.

Conclusion

- 5. Examiner indicated that this action is made final and provided information concerning the extension of time policy. Applicants believe that this reply is fully responsive to this action and that it is made within the permitted extension period of time.

6. Examiner indicated a shortened statutory period for reply to this final action and provided information concerning the period for reply. Applicants believe that this reply is fully responsive to this action and that it is made within the permitted extension period of time.

7-9. Examiner has provided information concerning communication and/or inquiries concerning this case. Applicants appreciate Examiner's willingness to communicate and assistance regarding this case. Applicants believe no response to this paragraph is necessary.

In view of the foregoing, and in summary, Applicants believe that all issues and points of the Examiner's Office action have been addressed, and that the newly inserted claims (23-31) are patentable. Applicant respectfully requests reconsideration and allowance of this application.

Dated this 12th day of July 2002.

Respectfully submitted,


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